UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,672	08/16/2005	Oleg Stenzel	264704US0PCT	1797

22850 7590 06/10/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
SMITH, JENNIFER A	
ART UNIT	PAPER NUMBER
1793	

NOTIFICATION DATE	DELIVERY MODE
06/10/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/522,672	STENZEL ET AL.	
	Examiner	Art Unit	
	JENNIFER A. SMITH	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) *5-15,17 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

In view of the appeal brief filed on 04/24/2009, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/J.A. LORENGO/

Supervisory Patent Examiner, Art Unit 1793.

Claim 20, added on 07/28/2008 after the first Office Action (dated 03/28/2008) had previously not been treated on its merits, in error. The new claim is included in the prior art rejection below. No new grounds of rejection have been added.

Finality of the last Office Action is withdrawn.

Claims 5-15, 17, and 19 remain withdrawn.

Claims 1-4 **and 20** are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.,* 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uhrlandt et al. US Patent No. 6,180,076 B1, as generally set forth in the Office Action dated 11/14/2008

In regard to claims 1 and 20, Uhrlandt et al. teach a precipitated silica with the characteristics [Claim 1]:

- BET surface area is 120-300 m^2/g
- CTAB surface area is 100-300 m^2/g
- DBP index number is 150-300g/100g

Therefore Uhrlandt et al. teach the ranges claimed in the instant application but fail to teach the claimed range of Sears number.

Uhrlandt et al. teach a Sears index, defined as consumption of 0.1 N NaOH, at a value of 6-25 ml [Claim 1] while the instant claim is drawn to a product with a Sears number, defined as V_2, at a value of 23-35 ml/(5g). Looking to the instant specification to equate these two values, Applicant writes that the measurements are standardized to theoretical weighted samples of 1 g and extended by five [Page 16, lines 12-13]. The Sears number in the Uhrlandt reference and the present application are not calculated in the same manner. Uhrlandet et al. note the Search index is calculated in accordance with G.W. Sears, Analy. Chemistry 12 (1956) 1982. In this method of calculation each titration uses 1.5 grams of silica in 150 ml of solution. Therefore, extending the values in the Uhrlandt reference to 5g (20-83 ml/5g) would encompass the claimed ranges in claims 1 and 20and the product disclosed in the Uhrlandt reference is thought to be substantially the same as the product of instant claim 1.

In addition, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to determine this parameter (Sears number) because it is a measure of the concentration of hydroxyl groups on the surface of the silica.

In regard to claim 2, Uhrlandt et al. teach CTAB surface area is 100-300 m^2/g in claim 1. Therefore a maximum of 300 m^2/g is taught.

In regard to claim 3, Uhrlandt et al. teach the wK coefficient is the ratio of the peak height of the non-degradable particles (B), the maximum of which lies in the range of 1.0-100 µm, to the peak height of the degraded particles (A), the maximum of which lies in the range of <1.0 µm [See Figure 6 or Column 6, lines 27-30]. The WK coefficient is taught in the Uhrlandt reference to be less than 3.4 [See Claim 1].

In regard to claim 4, Uhrlandt et al. teach modifying the precipitated silica with organosilanes of the formula I to III [See Column 3, lines 55-65]. The disclosed formulas are the same as those of the instant claim 4.

Response to Arguments

Applicant's arguments filed on 04/29/2009 have been fully considered but they are not persuasive.

In response to applicant's argument that Uhrlandt et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both the Uhrandt reference and the instant application are drawn to silica which is to be used as a filler in vulcanizable mixture for the production of tires.

Applicant argues the higher CTAB values are unexpected. The Urlandt reference overlaps with the claimed ranges (including CTAB values) and "in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)". See MPEP 2144.05 I.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the dynamic modulus tests, values of rigidity,) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The declaration filed under 37 CFR 1.132 filed on 07/28/2008 is insufficient to overcome the rejection of the claims because the declaration has not been signed. The declaration filed under 37 CFR 1.132 filed on 08/25/2008 has been signed; however it refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. The teachings of the declaration are drawn to the dynamic modulus and tensile strength and other characteristics which are not claimed. Furthermore the CTAB surface area value of the claimed invention is previously disclosed in the Uhrlandt et al. reference used to reject the claims.

Conclusion

Claims 1-4 and 20 are rejected.

No claims are allowed.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER A. SMITH whose telephone number is (571)270-3599. The examiner can normally be reached on Monday - Friday, 9:30am to 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.A. LORENGO/
Supervisory Patent Examiner, Art Unit 1793

Jennifer A. Smith
June 5, 2009
Art Unit 1793